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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/746,616	12/21/2000	Takashi Matsumoto	FUJI 18.144	2180
26304	7590	07/12/2005	EXAMINER	
KATTEN MUCHIN ROSENMAN LLP			PATEL, JAY P	
575 MADISON AVENUE			ART UNIT	
NEW YORK, NY 10022-2585			PAPER NUMBER	

2666

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/746,616

Applicant(s)

MATSUMOTO ET AL.

Examiner

Jay P. Patel

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 and 14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 and 6 is/are rejected.
- 7) ☒ Claim(s) 4-5 and 14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2000 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/20/2000.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 3 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Emery et al. (US 6519242 B1) further in view of Sieppi (US Patent 6577637 B1).

In regards to claims 1 and 3, Emery teaches a method of registering an IP terminal device and connecting a gateway device and said IP terminal device through an IP network. In figure 1, Emery shows a registration process when a subscribers logs into the home network. After the subscriber connects to the IP telephone to the home IP network, the registration is initiated with the local gatekeeper (see figure 1, IP telephone 10, IP network 20 and Gatekeeper 30; column 3 lines 38-41). The gatekeeper subsequently forwards the registration information to a home location register (HLR) (see figure 1, HLR 40; see column 3, 41-49).

In further regards to claims 1 and 3, Emery fails to teach connecting a line-switching exchanger and a network-gateway device by use of a radio-base-station-connection line that is used form connecting radio base stations. Sieppi teaches the above-mentioned limitation. Figure 4a shows a gateway exchange connected to a PBX (private branch exchange) and the operations are controlled by the Mobile station

controller when a mobile unit wishes to initiate a call setup to a second subscriber station (see figures 4a and 7a; column 3, lines 9-21).

Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the registration process disclosed by Emery to include a connection line to the PBX. The proper motivation comes from Sieppi where he states "If internet telephones become more and more common in the future, it might be wise from the network utilization point of view to route the call from the telephone network to the IP-network from the network unit where the call is originated from" (see column 2, lines 27-31).

In regards to claim 2, Emery teaches transmitting location-registration information of said IP terminal device used form registering information about a location of said IP terminal device to network-gateway device. In figure 1, Emery shows a registration process when a subscribers logs into the home network. After the subscriber connects to the IP telephone to the home IP network, the registration is initiated with the local gatekeeper (see figure 1, IP telephone 10, IP network 20 and Gatekeeper 30; column 3 lines 38-41).

In further regards to claim 2, Emery teaches registering location information about said IP terminal device in said database based on the location-registration information of said IP terminal device. The gatekeeper subsequently forwards the registration information to a home location register (HLR) (see figure 1, HLR 40; see column 3, 41-49).

Emery fails to particularly teach registering information about a location of said IP terminal device to said line-switching exchanger. Sieppi teaches the above-mentioned limitation. Figure 4a shows a MSC connected to a gateway exchange which is in turn connected to a PBX (private branch exchange) and the operations are controlled by the Mobile station controller when a mobile unit wishes to initiate a call setup to a second subscriber station (see figures 4a and 7a; column 3, lines 9-21).

Therefore it would have been obvious to one skilled in the art at the time the invention was made to modify the registration process disclosed by Emery to include a connection line to the PBX. The proper motivation comes from Sieppi where he states "If internet telephones become more and more common in the future, it might be wise from the network utilization point of view to route the call from the telephone network to the IP-network from the network unit where the call is originated from" (see column 2, lines 27-31).

In regard to claim 6, Emery teaches all the limitations of claim 3 in combination with Sieppi as stated above. Emery fails to particularly teach the line switching exchanger being a private branch exchange (PBX). Sieppi shows in figure 4a a PBX connected to a network gateway.

Therefore it would have been obvious to one skilled in the art at the time the invention was made to combine the PBX disclosed by Sieppi into the IP registration system disclosed by Emery. The motivation used with regards to claims 1-3 is also applicable to claim 6.

Allowable Subject Matter

3. Claims 4-5 and 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jay P. Patel whose telephone number is (571) 272-3086. The examiner can normally be reached on M-F 9:00 am - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema S. Rao can be reached on (571) 272-3174. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JPP 7/6/05
Jay P. Patel
Assistant Examiner
Art Unit 2666


DANG TON
PRIMARY EXAMINER

Application/Control Number: 09/746,616
Art Unit: 2666

Page 6